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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/007,522 | 12/06/2001 | Kan Ebisawa | 450100-3580.2 | 3713 |

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| EXAMINER | |
|---|---|
| JEANTY, ROMAIN | |
| ART UNIT | PAPER NUMBER |
| 3623 | |

DATE MAILED: 06/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

| Application No. | Applicant(s) |
|---|---|
| 10/007,522 | Ebisawa |
| **Examiner** | **Art Unit** |
| Romain Jeanty | 3623 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on *Mar 13, 2001* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *53-235 and 266-283* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) *144-235* is/are allowed.

6) ☒ Claim(s) *53-143 and 266-283* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5
4) ☒ Interview Summary (PTO-413) Paper No(s). 8
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

## DETAILED ACTION

1. This communication is responsive to the amendment filed on March 3/2002. No claims have been amended or added. Claims 53-235 and 266-283 are pending in the application.

### Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it does not identify the post office address of each inventor. A post office is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should include the Zip Code designation.

### Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 53-143 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-52 of U.S. Patent No. 5,946,664 in view of Roskowski et al (U. S. Patent No. 5,624,316). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

As per claims 53, 68, 83, 99, 114, 129, U.S. Patent No. 5,946,664 claims all of the limitations in a word for word manner in claims 1, 26 and 52 except "executable game" and "being operable". Roskowski et al discloses a video game enhancement system comprising an executable game logic. Note column 3 lines 55-66. It would have been obvious to a person of

ordinary skill in the art to modify the (664) patent by including a executable program logic as evidenced by Roskowski et al for the motivation of enabling a video game to be displayed.

The following claims are correspondingly equivalent:

| **U.S. Patent No. 5,946,664** | **Application No. 10/007,522** |
|---|---|
| 2 | 53, 69, 84 and 100 |
| 3 | 54, 70, 85 and 101 |
| 4 | 55, 71 , 86 and 102 |
| 5 | 56, 72, 77, 87, 103 and 108 |
| 6 | 59, 74, 90 and 105 |
| 7 | 60, 75, 91 and 106 |
| 8 | 61, 76, 92 and 107 |
| 9 | 63 and 94 |
| 10 | 62, 78, 93 and 109 |
| 11 | 64, 79, 95 and 110 |
| 12 | 65, 80, 96 and 111 |
| 18 | 58, 73, 89 and 104 |
| 26 | 114 and 129 |
| 27 | 115 and 130 |

| | |
|---|---|
| 28 | 116 and 131 |
| 29 | 117 and 132 |
| 31 | 119 and 134 |
| 32 | 120 |
| 33 | 121 |
| 34 | 122 and 135 |
| 35 | 123 |
| 36 | 124 |
| 37 | 125 and 140 |
| 38 | 126 and 141 |
| 46 | 136 |
| 47 | 137 |
| 48 | 138 |
| 49 | 139 |
| 43 | 118 and 133 |
| 52 | 57 |

As per claims 66, 67, 81, 82, 97, 98, 112, 113, 127, 128 142 and 143 the Internet is old and well known to be used for sending and receiving information "advertisements". It would have

been obvious to a person of ordinary skill in the art to have used the Internet/glogal network to receive the disclosed advertisement data of the applicant's invention in order to provide advertisement information to people all over the world.

**Claim Objections**

5. Claim 213 is objected to because of the following informalities: It appears that "is note" should have been --is not--. Appropriate correction is required.

**Claim Rejections - 35 USC § 112**

6. Claim 269 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 269, it is unclear as to what "second display area" applicant is referring to. Applicant is requested to amend the claim to recite a proper antecedent basis for the claim.

**Claim Rejections - 35 USC § 103**

7. Claims 266-267, 269-270, 272-273, 275-276, 278-279, 281-282 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilmore (UK Patent No. 2141907A) in view of Reilly et al (US. 5,740,549).

As per claims 266, 269, 272, Gilmore discloses a video game with advertising facility comprising:

Storage means (see FIG. 3, element 1 and page 2, lines 34-40), for storing a program;

Gilmore further discloses program execution means (see FIG. 3, element 1 and page 2, lines 34-40), for executing the program stored in storage means 11 and 12, and for outputting (via television screen 6) advertising information.

Transmitting means (see FIG. 3, element 5), for transmitting advertising to a recipient. Note page 2, lines 65-66;

Gilmore does not explicitly disclose displaying the advertisement in a second display. However, Reilly et al discloses an advertising distribution system that displays advertisement scripts in a second display (See FIG. 6, element 232 and col. 4, lines 50-65). It would have been obvious to a person of ordinary skill in the art at the time the inventions was made to modify the video game apparatus of Gilmore by incorporating a second display as evidenced by Reilly et al. Doing so would enable Gilmore to provide advertisements to a present advertising and other information simultaneously.

As per claims 267, 270, 273, 276, 279, 282, Gilmore further discloses receiving new advertisement data at predetermined times (when a game is played, daily, when the apparatus is turned on, and/or any number of game-specific or user-specific times (see abstract).

As per claims 275, 278, 281, Gilmore discloses a video game with advertising facility comprising;

Receiving means (see FIG. 3, element 5 and page 2, lines 28-40), for receiving a program that displays advertising information.

Receiving means (see FIG. 3, elements 5 and 13 and page 2, lines 49-53) for receiving new advertisement data at predetermined times..

Gilmore does not explicitly disclose displaying the advertisement within a second display area. However, Reilly et al discloses an advertising distribution system that displays advertisement scripts in a second display (See FIG. 6, element 232 and col. 4, lines 50-65). It would have been obvious to a person of ordinary skill in the art at the time the inventions was made to modify the video game apparatus of Gilmore by incorporating a second display as evidenced by Reilly et al. Doing so would enable Gilmore to present advertisements and other information simultaneously to a user.

8. Claims 268, 271, 274, 277, 280, 283 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilmore (UK. Patent No. 2,141,907) in view of Reilly et al (5,740,549) and further in view of Hornbuckle (US Patent No. 5,497,479).

As per claims 268, 271, 274, 277, 280, 283, Gilmore does not explicitly disclose the transmission of an identification code identifying a game to be executed. Hornbuckle discloses a gaming system which discloses the well system of transmitting of a game identification code. Note col. 4, lines 4-23. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the video games apparatus of Gilmore by including an identification code as evidenced by Hornbuckle. Doing so would enable Gilmore to identify the program for execution and eliminating the chances of executing an unwanted game.

**Allowable Subject Matter**

9. Claims 144-235 are allowable

10. The following is a statement of reasons for the indication of allowable subject matter:

Prior art of record taken alone or in combination fails to teach or suggest transmitting the advertisement data relating to at least one advertisement at predetermined times and output display data incorporating the stored advertisement data within an original display data generated by said program

**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed **Romain Jeanty** whose telephone number is **(703) 308-9585**. The examiner can normally be reached on weekdays from 7:30 a.m to 6:00 pm.
If attempts to reach the examiner are not successful, the examiner's supervisor, **Tariq R Hafiz** can be reached at **(703) 305-9643**.

Any inquiry of a general nature or relating to the status of this application or preceding should be directed to the group **receptionist** whose telephone number is **(703)308-1113**.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C 20231**

or faxed to:

**(703) 305-7687**

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington VA., seventh floor receptionist.

RJ

May 30, 2002.

KYLE J. CHOI
PRIMARY EXAMINER
Art Unit 3623